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EXAMINER

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte JAMES E. ROSS and WILLIAM J. LYNCH

Appeal 2007-1587
Application 09/901,512
Technology Center 3600

Decided: June 30, 2008

Before HUBERT C. LORIN, ANTON W. FETTING and
JOSEPH A. FISCHETTI, *Administrative Patent Judges*.

FISCHETTI, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellants have filed a Request for Rehearing (Request) under 37 C.F.R. § 41.50(b)(2) (2007) and 37 C.F.R. § 41.52(a)(1) (2007) for reconsideration of our Decision of February 29, 2008. The Decision affirmed the Examiner's rejection of claims 7, 13, 37-40 under 35 U.S.C. § 102 (b) and claims 8-12, 14, 41-44 under 35 U.S.C. § 103(a).

ISSUES

Appellants allege three points of error in our Decision as follows:

- A. Whether the case law supports the Board's position that certain recited elements of Appellants' claims can be disregarding during determinations of patentability of the presently pending claims in view of the prior art;
- B. Whether Collen discloses a variety of grease board views; and
- C. Whether any of the alternative grease board views recited in claims 10-12 and 42-44 are patentable over the prior art.

RESPONSE TO ARGUMENTS

A. Appellants argue that “. . . the Decision erred in disregarding recited elements of Appellants' method and system claims by applying standards generally applied to data structures.” (Request, pg. 5.) However the law applicable to treating nonfunctional descriptive material is not confined to data structures alone as Appellants allege, but rather to how claimed context relates to the substrate on which it is presented. Cases such as *In re Miller* , 418 F.2d 1392 (CCPA 1969) where the substrate was a spoon, and *In re Gulack*, 703 F.2d 1381 (Fed. Cir. 1983) where the substrate was an elastic band, show that the nonfunctional descriptive material test can be applied in the context of a variety of substrates, not simply in memory medium.

Appellants also argue that “the cases relied upon in the Decision are irrelevant in the context of statutory processes and systems. *In re Lowry*

pertains to the patentability of a data structure, not a statutory process.” (Request, pg. 5.) However, initially we note that this argument pertains to only claims 7-14 which are drawn to a method. The majority of claims on appeal namely, claims 37-46, are drawn to a system. Regarding claims 7-14 drawn to the method of accessing data, the arguments in favor of patentability would still hinge on the descriptive content the screen displays instead of the step that is performed. It is the step(s) and not content that must define invention over the prior art in a process claim.

Appellants further argue “...the Board's decision ...automatically disregard[s] nonfunctional recitations” (Request, pg. 4.) We disagree that our Decision automatically disregards any claim element. In fact, the Decision takes careful measures to insure that Appellants were given a detailed explanation (1.) identifying the nonfunctional descriptive material, and (2.) explaining why such has no relationship to the involved substrate. Specifically, the Decision explains:

We are unconvinced that the language of independent claims 7 and 37 requires a grease board view to have the specific content of “active patient records” data. This is because we find the “active patient records” data, (room location, patient's name, patient's physician, nursing orders, patient priority and elapsed time of stay, status of assignment of nurse and physician, and status of X-rays, labs, tests, nurses' orders, records, dictation and vital signs) to be nonfunctional and descriptive (FF 4). That is, the “active patient records” data is not functionally related to the computing process

in that the presentation of this information on the display or substrate occurs without regard to the content of this data. (FF 4)

(Decision pg. 12.) We thus find no basis for Appellant's assertion of an automatic handling of the nonfunctional descriptive material in the claims.

Finally, Appellants allege that the nonfunctional descriptive material which "... the Decision disregards (see Decision page 12) [is] ... in actuality definitional language used to define the nature of the 'active patient list grease board' views presented in accordance with the recited 'displaying' element in each of a set of dependent claims." This argument is circular in that it seeks to quantify the nonfunctional descriptive material as definitional to the grease board by attempting to limit the grease board by the content it displays, which cannot distinguish patentability.

B. Appellants next argue "Collen does not state that the general index displays a listing of patients. The Decision does not identify any disclosure within Collen supporting a conclusion that the general index control causes a listing of active patients in a grease board view." (Request, pg. 6.)

Appellants again seek to have the Board decide patentability based on the content of what is being displayed on given screen, and not on the architecture of the system involved. What matters is that the Decision does find that the system in Collen controls the selection of at least two different formats by actively selecting either LOCAL CENSUS or GENERAL INDEX screens in a manner similar to that of Appellants' Tracking Module 35 U.S.C. § 102 (b). (Decision (FF 7))

C. Appellants finally argue "...Collen's general index is clearly not a grease board view since it does not display an active patient list." (Request, pg. 6.) Again, Appellants seek to define the invention by the content of a screen which we have concluded cannot be the subject of patentability when the content has no function except for what it expresses on the screen.

For the reasons above, we are not convinced that Appellants have shown with particularity points believed to have been misapprehended or overlooked by the Board in rendering its earlier decision. *See* 37 C.F.R. § 41.52(a)(1) (2007). Accordingly, Appellants' request for rehearing is denied.

CONCLUSIONS OF LAW

We conclude:

Our decision to affirm the decision of the Examiner to reject the claims on appeal under 35 U.S.C. § 103(a) over prior art has not been shown to have been erroneous.

This decision on rehearing is a FINAL agency action.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv) (2007).

REHEARING DENIED

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